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In re Application of CROCKARD et al
U.S. Application No.: 10/570,588
PCT Application No.: PCT/GB2004/003773
Int. Filing Date: 02 September 2004
Priority Date Claimed: 03 September 2003
Attorney Docket No.: 30986/40924
For: DIAGNOSIS OF RISK OF BREAST
CANCER

DECISION

This is in response to applicant's petition to withdraw a holding of abandonment under 37 CFR 1.181 filed 24 March 2009.

BACKGROUND

On 02 September 2004, applicant filed international application PCT/GB2004/003773, which claimed priority of an earlier United Kingdom application filed 03 September 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 17 March 2005. The thirty-month period for paying the basic national fee in the United States expired on 03 March 2006.

On 03 March 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 22 November 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497, a sequence listing in computer readable form, and a sequence listing statement must be filed.

On 22 January 2007, applicant filed an executed declaration, a sequence listing in computer readable form, and a sequence listing statement.

On 24 August 2007, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that the sequence listing in computer readable form filed 22 January 2007 was defective.

On 10 March 2009, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909), which indicated that the present application is abandoned for failure to timely respond to the Notification of Defective Response.

On 24 March 2009, applicant filed the present petition under 37 CFR 1.181.

DISCUSSION

MPEP 711.03(c), Section I. A., "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action" states in relevant part,

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The present petition states that the Notification of Defective Response was not received, states that a search of the practitioner's records, including any file jacket or the equivalent, and the application contents, indicates that the Notification of Defective Response was not received, and includes a detailed statement describing the system used for recording an Office action received at the correspondence address of record and establishing that the docketing system is sufficiently reliable. However, the supplied docket record is insufficient. Petitioner must provide a copy of the master docket record for the practitioner's firm, listing all replies docketed for the due date for reply to the Notification of Defective Response. In other words, the master docket record should list all cases handled by the representative's firm, sorted by the due date for

reply.¹ If such a docket record is not available, the practitioner must so state and explain why such a docket record cannot be generated.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181".

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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¹ Petitioner need only supply the sorted results corresponding to 24 September 2007.